

REMARKS

In the Final Office Action¹, the Examiner:

rejected claims 17-24, 33, 34, 36- 39, 68-75, 84, 85, 87-90, 104, 107, 110, 113, 116, 119, 126, and 128 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,546,005 to *Berkley*;

rejected claims 1-14, 52-65, 103, 106, 109, 112, 115, 118, 123-125, and 127 under 35 U.S.C. § 103(a) as unpatentable over *Berkley* in view of U.S. Patent No. 6,687,340 to *Goldberg*; and

rejected claims 25-31, 76-82, 117, and 120-122 under 35 U.S.C. § 103(a) as unpatentable over *Berkley* in view of U.S. Patent No. 6,535,596 to *Frey*.

By this Amendment, Applicants propose to amend claims 1, 17, 18, 52, 68, 69, 103, 104, 106, 107, 109, 110, 112, and 113.

I. The Rejection Under 35 U.S.C. § 102(e)

Applicants traverse the rejection of claims 17-24, 33, 34, 36, 39, 68-75, 84, 85, 87-90, 104, 107, 110, 113, 116, 119, 126, and 128 under 35 U.S.C. § 102(e).

Berkley does not teach or even suggest each and every element of the claims.

Claim 17, for example, recites a method comprising "determining whether the preferred device of the user requires a different data format than the device used by the calling party to initiate the communication [and] sending information to the calling party indicating that the calling party should contact the user at the preferred device of the

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome this rejection, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to the rejection (e.g., whether a reference constitutes prior art, ability to combine references, assertions as to patentability of dependent claims) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

user, when the preferred device of the user requires a different data format than the device used by the calling party to initiate the communication" (emphasis added).

Berkley discloses an Active User Registry (AUR) system including a database integrated into a plain old telephone service (POTS) network and a packet network such as the Internet (*Berkley*, abstract). The AUR database includes a data structure of ways in which users can be reached through the POTS and the packet network, and the AUR uses the database to broker between a subscriber's request for communications with a user and the user's preference for being reached by various communication alternatives (*Id.*). For example, the subscriber may request the AUR system to contact a user by facsimile or by telephone by providing a user identifier corresponding to the user, and the AUR system compares the subscriber's request to the user's preferred options for being contacted (*Berkley*, col. 10, line 37 to col. 11, line 5). Alternatively, the AUR system may convert a message from one message media corresponding to the subscriber's request to another media required by the user's preferred communication options (*Berkley*, col. 12, lines 36-43).

For example, if the subscriber requests to send a fax to the user, but the user prefers email messages, the AUR system could allow the subscriber to send the fax through the AUR system, and convert the text of the fax to an email to the user via the user's preferred email address (*Berkley*, col. 50, lines 50-64). The Office Action relies on *Berkley*'s fax-to-email conversion as allegedly constituting "send[ing] information to the calling party indicating that the calling party should contact the user at the preferred device of the user, when the preferred device of the user requires a different data format than the device used by the calling party (Office Action at page 3). This is incorrect.

Berkley merely discloses converting the facsimile into an email and sending the information to the user contacted by the subscriber. However, *Berkley* does not disclose or suggest, for example, sending the email address of the user to the subscriber when the subscriber requests to send the facsimile to the user who prefers email. Accordingly, *Berkley* does not teach or suggest "determining whether the preferred device of the user requires a different data format than the device used by the calling party to initiate the communication [and] sending information to the calling party indicating that the calling party should contact the user at the preferred device of the user, when the preferred device of the user requires a different data format than the device used by the calling party to initiate the communication," as recited by independent claim 17 (emphasis added).

Accordingly, *Berkley* cannot anticipate independent claim 17. Independent claims 68, 104, 107, 110, and 113, though of different scope from claim 17, recite subject matter similar to that set forth above with respect to claim 1. Claims 18-24, 33, 34, 36, 39, 116, and 126 depend from independent claim 17, and claims 69-75, 84, 85, 87-90, 119, and 128 depend from independent claim 68, and are therefore allowable at least due to their dependence from allowable base claims.

II. The Rejections Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of the claims under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established.

A. Claims 1-14, 52-65, 103, 106, 109, 112, 115, 118, 123-125, and 127

Independent claim 1, for example, recites a method comprising, among other things, "sending contact information identifying a device associated with the calling party

to the preferred device of the user being contacted by the calling party in the data format of the preferred device, when the preferred device of the user being contacted by the calling party requires a different data format than the device used by the calling party to initiate the communication" (emphasis added).

As discussed, *Berkley* discloses an Active User Registry (AUR) system including a database integrated into a plain old telephone service (POTS) network and a packet network such as the Internet, and the AUR database includes a data structure of ways in which users can be reached through the POTS and the packet network (*Berkley*, abstract). The AUR uses the database to broker between a subscriber's request for communications with a user and the user's preference for being reached by various communication alternatives (*Id.*). However, the Final Office Action concedes that "*Berkley* fails to teach sending contact information for the calling party to the preferred device of the user" (Final Office Action at page 6). Accordingly, *Berkley* also fails to teach or suggest "sending contact information identifying a device associated with the calling party to the preferred device of the user being contacted by the calling party in the data format of the preferred device, when the preferred device of the user being contacted by the calling party requires a different data format than the device used by the calling party to initiate the communication," as recited by independent claim 1 (emphasis added).

Goldberg fails to cure the above-noted deficiencies of *Berkley*. *Goldberg* discloses a system and apparatus that provides a voice message of a calling party to a called party by converting the voice message to a digital file and sending an electronic mail message that includes the digital file to the called party (*Goldberg*, abstract).

Goldberg's system includes a network node 12 that is programmed to store a list of called parties that subscribe to the voice message system, as well as email addresses for the called parties (*Goldberg*, col. 2, lines 17-24 and FIG. 1). When a telephone call is routed to node 12, node 12 also receives information that identifies the called party (*Goldberg*, col. 2, lines 55-57). Node 12 then prompts the calling party to leave a voice message, converts the voice message into a digital file such as an audio or text file, and sends an email that includes the digital file to the called party (*Goldberg*, col. 3, lines 18-35).

The Final Office Action alleges that converting the voicemail to a digital file and sending the digital file to the called party constitutes "sending contact information for the calling party to the preferred device of the user in the data [format] of the preferred device [of the user]" (Final Office Action at page 6). This is incorrect. As discussed, *Goldberg* merely discloses sending the digitized voicemail to the called party (*Goldberg*, col. 3, lines 29-35). *Goldberg* does not, however, disclose or suggest sending contact information for the calling party to the called party. Furthermore, *Goldberg* fails to teach or suggest sending information identifying a device associated with the calling party to the called party. Accordingly, *Goldberg* also fails to teach or suggest "sending contact information identifying a device associated with the calling party to the preferred device of the user being contacted by the calling party in the data format of the preferred device, when the preferred device of the user being contacted by the calling party requires a different data format than the device used by the calling party to initiate the communication," as recited by independent claim 1 (emphasis added).

Accordingly, no *prima facie* case of obviousness has been established with respect to independent claim 1. Independent claims 52, 103, 106, 109, and 112, though of different scope from claim 17, recite subject matter similar to that set forth above with respect to claim 1. Claims 2-14, 115, 123, and 125 depend from independent claim 1, and claims 53-65, 118, 124, and 127 depend from independent claim 52, and are therefore allowable at least due to their dependence from allowable base claims.

B. Claims 25-31, 76-82, 117, and 120-122

Applicants respectfully traverse the rejection of claims 25-31, 76-82, 117, and 120-122 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established. Claims 25-31, 117, and 121 depend from claim 17, and claims 76-82, 120, and 122 depend from claim 68. As discussed, *Berkley* does not teach or suggest "determining whether the preferred device of the user requires a different data format than the device used by the calling party to initiate the communication [and] sending information to the calling party indicating that the calling party should contact the user at the preferred device of the user, when the preferred device of the user requires a different data format than the device used by the calling party to initiate the communication," as recited by independent claim 17 (emphasis added), or the similar recitations in independent claim 68.

Frey discloses a method and apparatus for processing a call from a calling party to a called party (*Frey*, abstract). *Frey* also discloses delivering the calling party's directory number to the called party (*Frey*, col. 9, lines 5-8). However, *Frey* does not disclose or suggest sending information to the calling party, or doing so when devices have different data formats. Therefore, *Frey* also does not teach or suggest

"determining whether the preferred device of the user requires a different data format than the device used by the calling party to initiate the communication [and] sending information to the calling party indicating that the calling party should contact the user at the preferred device of the user, when the preferred device of the user requires a different data format than the device used by the calling party to initiate the communication," as recited by independent claim 17 (emphasis added), or the similar recitations in independent claim 68.

For the reasons discussed above, claims 25-31, 76-82, 117, and 120-122 are allowable over the cited references, at least due to their dependence from allowable base claims.

III. Conclusion

Applicants respectfully request that the Examiner enter this Amendment under 37 C.F.R. § 1.116. Applicants submit that the proposed amendments would place the application in condition for allowance and do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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